

REMARKS

The Office Action of November 16, 2005 has been received and reviewed. Claims 11-16 are withdrawn, as being drawn to a non-elected invention. Claims 1, 17, 31, 32, 35, and 41 have been amended without prejudice or disclaimer. Claim 45 has been added. All of the pending claims 1-45 are presented below. All pending claims stand rejected. Reconsideration is respectfully requested.

The amendment to claims 1, 17, 31, 32, 35, 41, and 45 find support throughout the specification including in at least paragraphs 4 and 6; and, Figures 4 and 5.

In the Office Action of November 16, 2005, claim 40 was not rejected or indicated as allowable. Applicants respectfully request clarification of this issue.

Rejections under 35 USC §102

Claims 1, 2, 4-10, 17-38, and 41-44 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by US 6,638,276 ("the '276 patent"). The Examiner asserts that the '276 patent discloses a method of protecting spinal nerves and a method for performing spinal disc lesioning comprising inserting a first hollow needle comprising a first thermocouple into a first space between the spinal disc and nerve root; monitoring the temperature near the nerve root and reducing the temperature near the nerve root in response to the monitoring. Applicants respectfully request reconsideration in light of this response and the amendments to the claims

The '276 patent does not disclose a method of protecting spinal nerves and structures during spinal disc heat lesioning procedures, the method comprising:
inserting a first hollow needle comprising a first thermocouple and a first electrode into a first space between the spinal disc and an ipsilateral root;
stimulating the electrode to check for motor nerve response;
monitoring temperature near the ipsilateral root with the first thermocouple during spinal disc heat lesioning; and
reducing the temperature near the ipsilateral root in response to the monitoring to protect the ipsilateral root from thermal damage, as is claimed in amended claim 1.

There is no disclosure of an electrode that is stimulated to measure motor nerve response. Amended claims 17 and 31 claim further methods and have been amended similarly to claim 1 and are patentable for at least the same reasons. Claims 2, 4-10, and 18-31 depend from one of claims 1 or 17 and are allowable as depending from an allowable independent claim.

Likewise, the '276 patent does not disclose a needle for monitoring a spinal disc lesioning procedure, comprising:

- a hollow shaft;
- an injection opening allowing access to a bore of the hollow shaft, configured for allowing injection therethrough;
- an electrode attached to the hollow shaft for stimulating a tissue; and
- a thermocouple attached to the hollow shaft for monitoring temperature of the tissue surrounding the needle, as is claimed in amended claim 32.

Specifically, the '276 patent does not disclose an electrode attached to the hollow shaft for stimulating a tissue.

Claims 33 and 34 depend from claim 32 and are patentable for at least the same reasons as claim 32.

Further, the '276 patent does not disclose a kit for performing a spinal disc procedure, comprising:

- at least a first monitoring needle comprising a hollow shaft having a proximal and distal end, an injection opening allowing access to a bore of the hollow shaft, configured for allowing injection therethrough, a thermocouple attached to the hollow shaft for monitoring temperature of the tissue surrounding the at least one first monitoring needle;
- an electrode needle, comprising an electrode shaft having a distal end and a proximal end, and a conductive portion for applying energy to spinal disc tissue; and
- monitoring means for checking for tissue stimulation from the electrode needle, as is claimed in amended claim 35.

Specifically, the '276 patent does not disclose a monitoring means for checking for tissue stimulation from the electrode needle.

Claims 36-38 depend from claim 35 and are patentable for at least the same reasons as claim 35.

Lastly the '276 patent does not disclose an electrode needle for lesioning spinal disc tissue and stimulating for motor nerve response, the needle comprising:
a hollow shaft having a flexible distal tip and a proximal end; and
a conductive portion for applying lesioning energy to spinal disc tissue and for stimulating a tissue to measure motor nerve response, as is claimed in amended claim 41.

Specifically, the '276 patent does not disclose that the conductive portion of the electrode is used for stimulating a tissue to measure motor nerve response.

Claims 42 and 43 depend from claim 41 and are patentable for at least the same reasons as claim 41.

Accordingly, in light of this response and the amendments, Applicants respectfully request reconsideration and withdrawal of the rejections.

Rejections under 35 USC§103

Claims 3 and 39 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the '276 patent and what the Examiner refers to as knowledge in the art. Applicants respectfully request reconsideration in light of this response and the amendments.

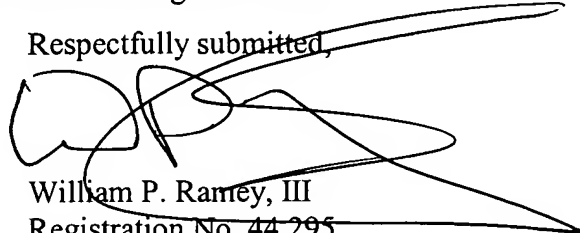
Claim 3 depends from amended claim 1 and therefore has all the limitations of amended claim 1. As the '276 patent does not disclose all elements of claim 1, the combination of the '276 patent and the knowledge of one of ordinary skill in the art does not disclose all of the elements of claim 3. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Likewise, claim 39 depends from amended claim 35 and therefore has all the limitations of amended claim 35. As the '276 patent does not disclose all elements of claim 35, the combination of the '276 patent and the knowledge of one of ordinary skill in the art does not disclose all of the elements of claim 39 because the Examiner used the knowledge of one of ordinary skill to supply a second needle. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

If questions remain after consideration of the foregoing, the Office is kindly requested to contact applicants' attorney at the address or telephone number given herein.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William P. Ramey, III', is written over the typed name and registration number.

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